

## **REMARKS**

This amendment is being filed by the applicant *pro se* following a Final Office Action dated April 16, 2008 and a personal interview with the Examiner and Supervisory Examiner on May 8, 2008.

Prior to the personal interview a “Proposed Agenda for Bushby Interview” document was faxed to the Examiner on May 4th, 2008 for “discussion/interview purposes”, and a copy was presented during the personal interview with the Examiner and Supervisory Examiner on May 8th, 2008. The May 4th, 2008 “Proposed Agenda for Bushby Interview” document was clearly presented as a proposed agenda and draft for purposes of discussion and, was not intended to be published for the record. However, the May 4th, 2008 “Proposed Agenda for Bushby Interview” document has been published in the “Public Pair” in an entry in the “Image File Wrapper” dated May 5, 2008. It is respectfully requested that the “Proposed Agenda for Bushby Interview” document be removed from the “Public Pair” database and not be published for the record.

## **35 USC 112 Rejections**

In the April 16, 2008 office action, claim 56 was rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The Office Action stated that the claim contained subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 56 was quoted improperly in the office action as reciting the limitation "strap and tab adhered to the outer skin surface of the foot provides additional resistance to lateral and longitudinal forces". The claimed limitation actually reads "strap or tab" and clear support was pointed out in the specification for this limitation, thus the rejection was in error. Claim 56 is currently amended to provide further clarity as to the purpose of straps, however the 112 rejection should still be removed.

In the April 16, 2008 office action, claims 44 and 56 were rejected under 35 USC 112, second paragraph. The office action stated that the limitations "the outer skin", "the sole", "the plantar fascia", "the region", "the heel" and "the distal end of the toes" were not clear and there was a lack of an antecedent basis for the claimed "the outer skin", "the sole", "the plantar fascia", "the region", "the heel" and "the distal end of the toes" in claim. The office action stated that these limitations must be replaced with "an outer skin", "a sole", a plantar fascia", "a region", "a heel" and "a distal end of the toes" to be presented properly. Corrective action has been taken. The term "a wearer's foot" has replaced "a foot" in claims 44, 56 and elsewhere in the claims along with other changes of "the" to "a" or "an" where appropriate.

In the April 16, 2008 office action, claims 44 and 56 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It was stated that claims 44 and 56 recite limitations of "sole engaging surface, and said stretch-resistant sole member" implying two structures. Corrective action has been taken, and the 112 rejections are now moot.

In the April 16, 2008 office action, claim 56 was rejected under 35 USC 112, second paragraph, because there was insufficient antecedent basis. The office action stated that the limitation of "strap and tab adhered to the outer skin surface of the foot provides additional resistance to lateral and longitudinal forces" in claim is not supported by the originally filed specification. During the interview it was pointed out that the limitation reads "strap or tab" and clear support was pointed out in the specification, by the applicant. This rejection was in error, as summarized in the interview summary.

In the April 16, 2008 office action, claim 53 was rejected under 35 USC 112, second paragraph, because there was insufficient antecedent basis for the term "said arch strap". This rejection was in error, as was summarized in the interview of May 8, 2008. The current claim 53 at the time of examination did not contain the limitation "said arch strap".

All 35USC 112 rejections of April 16, 2008 office action, have either been found to be in error (as confirmed by the interview summary) or have now been corrected. It is respectfully requested that based on the amendments and arguments above, that all 112 rejections be withdrawn.

#### U.S.C. §102 Rejections

In the April 16, 2008 office action, claims 44, 56, 62 and 66 were rejected under 35 U.S.C. §102(e) as being anticipated by Burgess (US 6,640,465). Claims 56, 62 and 66 all contain limitations, which were not clearly addressed in the office action of April 16, 2008 (as confirmed in the interview summary). By way of example: Claim 56 contains “at least one thin flexible strap or tab”, Claim 62 contains the limitation “excluding the region under the four smaller toes” and Claim 66 contains the limitation “adhering opposed ends of a thin flexible strap extending laterally outward from opposite sides of said stretch-resistant”. Additionally, claims 56, 62 and 66 contain other limitations for which the applicant’s position is that they are not anticipated by Burgess (US 6,640,465) an example of such is the limitation “stretch resistant”. Agreement was reached during the interview of May 8, 2008 that these 102(e) rejections will be withdrawn. Claim 44 had, and as currently amended still has limitations not anticipated by Burgess (US 6,640,465), such as, “having a shape matching less than the entire outline of a sole of the wearer's foot and sized to cover only a portion of the wearer's sole”.

Additionally, claim 44 contains other limitations such as “stretch resistant” not anticipated by Burgess (US 6,640,465). Additionally, the Office Action added limitations, with respect to the 102 rejections, which do not exist in the claim set which was current at time of examination. For example: “forces applied to the plantar fascia from the forces on an arch of the foot which push the bones of the foot downwardly”. It is respectfully requested, that the 102 rejection against claim 44 be withdrawn along with the 102 rejections against claims 56, 62, and 66, as agreed to during the May 8 interview.

#### “Finality” of the Office Action

The finality of the outstanding office action is respectfully requested to be withdrawn, due to the errors in examination under 35 USC 112 stated previously, the errors with regards to the 102 rejections stated above (and affirmed in the interview summary), errors in the 103 rejections (stated below) and the failure to examine claim 68. Should this request be denied, then entry of the amended claims 44- 69 is requested in order to clarify the claims for purposes of appeal.

It was suggested during the interview that if the new claims presented were to be included in this amendment, that a further search would be required. New claims 70-80 have been submitted based on the interview comments and expected withdrawal of “finality”, of the April 16

Office Action. It is submitted that these claims be entered, once it is officially determined that the “finality” of the April 16, 2008 office action has been withdrawn.

### **35 U.S.C. §103 Rejections**

#### **In view of Burgess:**

Claims 48-54 and 57-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgess (US 6,640,465). The Office Action held that Burgess discloses a device that has a uniform thickness (column 3 lines 52-54) of less than “about 30 mils”. The term “about 30 mils” is not found in any of the claims current at the time of examination. The correct limitation used in the claims which were current at time of examination would be less “than 30 mils” (0.762 mm). The applicant points out, that this thickness is outside the range required for Burgess to function in the manner intended, and of lesser importance, it is outside the range specified by Burgess. It would not have been obvious to use a material below the range of “1 mm to 5 mm”, because the material of Burgess is to serve as a “cushion” layer. For sake of clarity, converting Burgess’s mm to mils, Burgess teaches a desirable thickness in the range of from about **39.370 mil** (1mm) to about **196.850 mil** (5 mm), with a preferred thickness of about **78.740 mil** (2mm). It is the applicants view that a thickness of 1mm if not greater, would be required to provide the effect desired “cushion” effect. However more importantly with regards to claims 48-54 and 57-61 this rejection is in error, since none of the claims 48-54 and 57-61 utilize this limitation. The rejection is clearly in error and should be withdrawn. However, in view of the above arguments regarding merits (i.e. thickness ranges and thickness required to function as a cushion), and viewing these claims in their entirety (i.e. in light of the limitations found in the claims for which they depend) is submitted these rejections, be dropped, and that other objections based on thickness ranges, not be applied.

#### **The proposed combination of Burgess in view of Turtzo:**

Claims 48-54 and 57-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgess (US 6,640,465), in view of Turtzo (2002/0188239). The Office Action quoted limitations with respect to the rejections which do not exist in the claim set which was current at time of examination, for example: “forces applied to the plantar fascia from the

forces on an arch of the foot which push the bones of the foot downwardly". It appears that the response given was a copied from an earlier office action without regard to the limitations in the claims current at time of examination. However, the argument in the Office Action is that "At the time of the invention, it would have been an obvious to one skilled in art to have to make the device of Burgess to have straps having adhesive, as taught by of Turtzo to adding adhesive to the top surface of the device to have adhesive on top surface of the device to adhere the support device to the bottom of the foot and to secure the device better to sole of the foot". However, neither Burgess nor Turtzo utilize straps with adhesive for adhering the straps directly to the skin surface. Turtzo suggests adhesive on the strap ends (only) as a possible means for adhering the ends of the straps to each other, but does not suggest they be adhered to the skin. The rigid structure of Turtzo would not lead one to provide straps, which would be required to adhere to the skin, but rather to hold the ridged device of Turtzo against the foot, by encircling the foot with a strap. The tensile forces acting on the stretch resistant sole member of the current invention, coupled with its non-rigid sole, are advantaged by securely anchoring the sole member by adhering straps directly to the skin, in a manner not required by Burgess or Turtzo independently or in combination. Additionally, the applicant has provided modified wording in this current amendment to further clarify the roll of straps. Limitations "such as" providing a "further means to maintain said sole member in engagement with a sole of a foot" or to "maintain said sole member in position" have been added. In view of the above arguments and viewing these claims in their entirety (i.e. in light of the limitations found in the claims for which they depend) is submitted these rejections, be dropped, and that other objections based on a combination with Burgess, not be applied.

Additionally, 63, 64, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgess (US 6,640,465), in view of Turtzo. It is respectfully submitted that Claims 48-54, 57-61, 63, 64, and 65 are in an allowable condition, in light of the above arguments, amendments and in combination with the limitations found in their respective base claims. The applicant respectfully requests that these 103 rejections be withdrawn.

The comments in the Office Action with respect to claims 44, 56, and 60, the limitations of "restricting extension and stretching of the outer skin tissue on the sole of the foot", when the device described above adheres to sole, such that the tension forces applied to the plantar fascia "from the forces on an arch of the foot which push the bones of the foot downwardly"

**are not based on language found in the claims current at time of examination and should be withdrawn.** The combination of Turtzo and Burgess in the manner suggested is not appropriate without destroying the functionality of Turtzo. Turtzo is rigid and it applies an intentional stretching or tension to the plantar fascia. This teaches away from the current invention. Burgess moves easily with the foot as not to restrict movement and thus does not prevent stretching of the plantar fascia. In light of these arguments made on the merits, the entirety of the limitations found in claims 44, 56, and 60 and the current amended language, it is respectfully requested that 103 rejections not be held against claims 44, 56, 60 or any against any claims, which are dependent upon these claims.

**Burgess in view of Huddleston et al (US 4,997,709):**

In the April 16, 2008 office action, claims 47, 67, & 69 are rejected under 35 U.S.C. §103(a) as being unpatentable over Burgess in view of Huddleston et al (US 4,997,709).

It is respectfully submitted that the proposed combination and modification is not suggested and, even if combined, does not suggest the device as recited in claim 47, 67 or 69. Claim 47 contains all of the structural and functional features of base claim 44 plus additional structural limitations directed toward the stretch-resistant properties of Applicant's device wherein the stretch-resistant sole engaging surface has less than 15% elongation when subjected to a tensile load (lb/in-width) approximately equivalent to 25 pounds/inch in accordance with ASTM D3759. Like claim 47, claims 67 and 69 contain all of the structural and functional features of their respective base claims plus additional structural limitations directed toward the stretch-resistant properties of Applicant's device wherein the stretch-resistant sole engaging surface has less than 15% elongation when subjected to a tensile load (lb/in-width) approximately equivalent to 25 pounds/inch in accordance with ASTM D3759

The primary reference Burgess teaches away from the desirability of a thin flexible stretch-resistant device having less than 15% elongation when subjected to a tensile load approximately equivalent to 25 pounds/inch. Burgess teaches a "resilient" sheet or "cushion member" of substantially uniform thickness that has enough "resilience, or cushion effect", "to provide comfort to the foot" of the wearer that "allows increased mobility" as the foot protector is able to

adjust to “flexing of the foot” during normal walking or running movements “without inhibiting foot movement.”

The secondary Huddleston et al reference (US 4,997,709) is directed toward a pressure-sensitive adhesive meeting Underwriter Laboratories, Inc. 181A requirements and specifications for foil tapes for use with rapid fiberglass air ducts, including the average tensile strength requirements as determined in accordance with the Standard Test Method for Tensile Strength and Elongation of Pressure-Sensitive Tapes, ASTM D3759-83.

Merely because foil tapes having an adhesive meeting the average tensile strength requirements as determined in accordance with the ASTM D3759-83 Standard Test Method for Tensile Strength and Elongation of Pressure-Sensitive Tapes are known, it does not necessarily follow that it would be obvious employ this feature in a device for application to a human foot or to combine it having all of the features of Claims 47, 67 or 69 alone or when including the limitations of the base claims from which these claims depend. Further, just because the test method of ASTMD3759 is used in applications such as Huddleston, does not lead one to conclude that a certain value of % elongation or range of elongation values would be suitable in an entirely different application, such as the one in the current invention. The Huddleston reference does not suggest, motivate or lead one to conclude that less than 15% elongation by mean of test method ASTM D3759, would be suitable or desirable for any device applied to the sole of a human foot.

Claim 47 should be considered in its entirety including all of the limitations of base claim 44. Applicant is not attempting to claim the stretch-resistant properties independently apart from the whole combination, nor suggesting that this individual feature be withdrawn from the public domain, but is claiming it only in combination with the specific combination of structural and functional features recited in base claim 44. Even if it were legitimate to combine and modify the references, the proposed combination would not produce all of the elements of claim 47 including all of the structural and functional features recited in base claim 44 working together as a whole. The applicant presents the same argument as stated for claim 47 above for claims 67 & 69, which depend on claims 56 and 62.

Therefore, it is respectfully submitted that dependent claim 47, 67 & 69 including all of the structural and functional features recited in their base claims working together as a whole and in light of all arguments made above should be allowable.

**Burgess in view of Dalton ( US 7,107,705):**

Claim 55 was rejected under 35 U.S.C. §103(a) as being unpatentable over Burgess in view of Dalton ( US 7,107,705). The applicant did not agree with this rejection, based on view of this claim in its entirety with the limitations of its base claim, however this claim has been modified in the current amendment, wherein the Dalton reference is no longer an issue. Claim 55 no longer includes medicinal additives, anti-fungal treatments, anti-microbial treatments, anti-inflammatory treatments, deodorants, and tea tree oil. It is submitted that claim 55 is in allowable form.

**Support of Amended Language**

**Support for the language added in this amendment is found as follows:**

The limitation “having a shape matching less than the entire outline of a sole of a wearer's foot” ... “and sized to cover only a portion of the wearer's sole,” is supported by paragraphs [0018] (“shaped to cover only a portion of the bottom of the foot”), [0060] (“may be shaped to resemble the outline”) and [0068] of the application as originally filed, and does not constitute new matter.

The terminology, “securely adhering” as used in claim 44 and elsewhere finds support in paragraph [0036] (“secured in place by contact between the adhesive and the outer skin surface”), [0031] (“strong enough adhesive”) as well as being an inherent property of the invention, demonstrated throughout the application as originally filed, and does not constitute new matter.

The limitation “to maintain said sole member in position on the sole of a wearer's foot” finds support in paragraphs, [0032], [0036], and [0040], of the application as originally filed, and does not constitute new matter. The limitation “to maintain said sole member in adhesive engagement (or adhesively engaged) with a sole of the wearer's foot” is support by the fact that the sole member is adhesively engaged with the sole of the wearer's foot [0028], [0029], [0030] and [0031] and that the straps “maintain the sole member in position on the sole of a wearer's foot” [0032], [0036], and [0040],

The limitation “a ratio of elongation (%) to tensile strength (lb/in-width) that is less than 0.9 to provide a balanced combination of strength and resistance to elongation,” finds support in paragraph [0059] of the application as originally filed, and does not constitute new matter.

### Summary

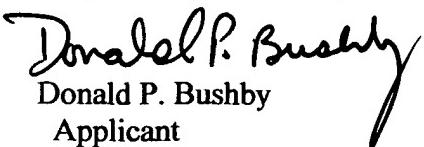
Therefore, it is respectfully submitted that independent claims 44, 56, 62 or 66 contain a combination of elements working together as a whole and that function in a manner not anticipated or obvious based on the teachings of Turtzo, Burgess, Huddleston or Dalton, alone or in any combination, and should now be allowable claims. Claims depending on these claims contain the base limitation of these claims and should therefore also not be anticipated or obvious based the teachings of these sources alone or in combination. The claims have also been reviewed in light of the prior art made of record in the April 16, 2008 office action. In view of the foregoing amendments, explanations and remarks, it is respectfully requested that claims 44-69 be allowed, and that this application be passed to issue.

New claims 70-80 have been carefully constructed in light of all prior art of record and are submitted to be in allowable form. It has been requested that the “Finality” of the April 16, 2008 office action be withdrawn, and that new claims 70-80 be entered.

It is also respectfully requested that the proposed the May 4th, 2008 ““Proposed Agenda for Bushby Interview” document which has been published in the “Public Pair” in an entry in the “Image File Wrapper” dated May 5, 2008 be removed from the “Public Pair” database and not be published for the record.

A conscientious effort has been made to place this application in condition for immediate allowance. It is respectfully requested if the 102 and 103 rejections regarding claims 44 –69 are not withdrawn or if suggestions as to allowable language to overcome any such rejections are not made, that an appeal conference is respectfully requested. This amendment is presented by the inventor *pro se*, and if any further changes to the amendatory language of the claims is required please advise the applicant. The undersigned may be reached by telephone at (713) 299-7263.

Respectfully submitted,

  
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